

APR 16 1984



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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Washington, D.C. 20231

In re the Matter :

of :

PETITION UNDER
37 CFR §1.341(i)

R-1984-1

petitions under the provisions of 37 CFR §§1.182 and 1.341 from the action of the Office of Enrollment and Discipline refusing to award him a passing grade for his answers on the afternoon section of the registration examination given on April 12, 1983. The petition is treated as though it was filed only under the provisions of 37 CFR §1.341(i).

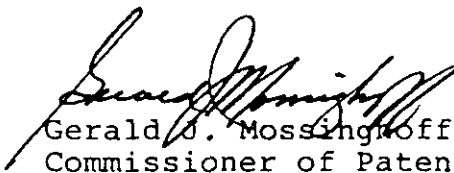
The relevant facts concerning petitioner's current efforts to be registered to practice in patent cases are as follows. Petitioner took the afternoon section of the registration examination given on April 12, 1983. Petitioner was notified on June 27, 1983 by the Chairman of the Committee on Enrollment that he had not obtained a passing grade on the afternoon section of the April 12, 1983 examination. After a series of communications between petitioner and the Committee, petitioner, on July 25, 1983, requested regrading of his April 12, 1983 examination papers. Petitioner was notified on August 4, 1983 by the Chairman of the Committee that, after careful consideration, the Committee still found that he had not attained a passing grade on the afternoon section of the examination. On August 24, 1983, petitioner filed a request for reconsideration contesting, in essence, the model answer and the reasons supporting the Committee's conclusion on regrade. On September 13, 1983, Mr. Feldman, Director of the Office of Enrollment and Discipline (OED), notified petitioner that the comments of the regrader were accepted, and after careful consideration, still found that petitioner had failed to attain a passing grade on the afternoon section of the examination. At the behest of Mr. . petitioner's examination papers were then independently reviewed by Mr. . a member of the Committee, and petitioner was informed on October 12, 1983 by the Director that in view of the opinion given by Mr. . no change in petitioner's failing grade was warranted. The instant petition was filed October 24, 1983.

¹ Any petition seeking a decision under 37 CFR §1.182 must be accompanied by the \$120 petition fee set forth in 37 CFR §1.17(h). No such fee has been paid.

It is the established policy of the Committee and of OED to prepare model answers for the questions propounded for each examination. These answers, together with the grader's comments with respect to the answers presented by the individual registration candidate, form the standard for evaluating the examination answers on request for regrade.

In view of questions newly advanced in the petition I have received the attached memoranda from Messrs. Feldman, Moatz and . These memoranda find, on review of the questions petitioner put in issue, no reasonable basis for concluding that petitioner passed the afternoon section of the examination. I concur. In grading and regrading petitioner's examination paper, the Committee, OED and Mr. : have not abused any discretion. Indeed, a review of petitioner's answer to the afternoon section shows there was reasonable basis for the Committee, OED and Mr. to find that petitioner had not passed the afternoon section of the registration examination of April 12, 1983.

The petition is denied.


Gerald J. Mossinghoff
Commissioner of Patents and Trademarks

Enclosures



**UNITED STATES DEPARTMENT OF COMMERCE
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Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

November 8, 1984

R-1984-1(R)

CERTIFIED MAIL RETURN
RECEIPT REQUESTED

In re the Matter

Of

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On Request For
Reconsideration

Petitioner, , requests reconsideration of the decision under 37 CFR §1.341(i) refusing to award him a passing grade on the afternoon section of the examination given on April 13, 1983.

It is petitioner's understanding that 15 points were deducted for not labeling his answer claims properly as broadest, intermediate and narrowest. Petitioner maintains that the graders failed to establish mislabeling and that the labeling was proper.

Contrary to petitioner's understanding, the 15 points deducted for the "Form of Claims" factors listed on the scoring sheet was not only for noncompliance with 37 CFR §1.75(b), but also for noncompliance with 37 CFR §1.75(c). Under §1.75(c), a dependent claim must refer back to and further limit another claim. The graders repeatedly pointed out and explained why claims 2 and 3, which refer back to and depend from claim 1, lack antecedent basis in claim 1 for certain limitations set forth in claims 2 and 3. Hence, dependent claims 2 and 3 do not further limit claim 1, and fail to comply with §1.75(c). Clearly, the 15 points were not deducted solely for mislabeling the claims.

The grader's, moreover, properly established that the claims were mislabeled. Specifically, the explanations of why claims 2 and 3 lack antecedent basis in claim 1 and of improper dependency fully justified a finding that the claims were mislabeled.

In support of his position that the claims were properly labeled, petitioner has, in effect, presented the same


arguments previously found to be unpersuasive. For whatever reason, petitioner has not faced the fact that that scope of claim 1 is not sufficiently broad to provide antecedent basis for the hydrogen bromide of claims 2 and 3; the 5'-hydroxy group on the phenyl ring of claims 2 and 3, the pharmaceutical carrier and dosages of claim 3, and the R₂ "methylphenyl of the formula-CH₂-C₂H₅" of the claim 3.

In support of his position that the claims are properly labeled, petitioner presents a declaration by Mr. Joseph H. Beuman, a registered patent attorney, and another declaration by Dr. David C. Sayles, a chemist, author and patentee. These declarations, virtually identical in pertinent part, state that the declarants "have reviewed EXHIBIT II attached hereto likewise, it is my opinion that claim 1 is broadest in scope, claim 2 is intermediate in scope, and claim 3 is narrowest in scope." The first two pages of EXHIBIT II appear to be true copies of claims 1 and 2. The third page of EXHIBIT II, however, appears to be a copy of claim 3 wherein brackets, which do not exist in the original claim 3, set apart the phrase "defined by claim 1...defined as being." Neither Mr. Beuman nor Dr. Sayles support his opinion with an explanation, logical reasoning, or analysis of each claim showing a correct understanding and application of the law of claim construction for patent applications. There is no showing that Mr. Beuman and Dr. Sayles were aware that there are no brackets in petitioner's actual answer for claim 3, or how their opinions were or should have been affected by the presence of the brackets. There also is no evidence of error in grading petitioner's labeling of his claims, and the opinions provided by Mr. Beuman and Dr. Sayles are unpersuasive of such an error.

In a "Memorandum For Record," Dr. Sayles finds that the test disclosure had numerous errors relating to 2-amino-3-(3'-hydroxyphenyl) propanols and salts thereof, particularly in not conforming with the nomenclature rules of the International Union of Pure and Applied Chemistry. It is assumed the errors Dr. Sayles had in mind are indicated by the red ink markings on the test disclosure attached to the Memorandum. The test material, however, contains correct structural formula of the named compounds. Moreover, most of

the red inked markings concern abbreviations, spellings and styles of expression. While every effort will be made to avoid such errors in the future, those which Dr. Sayles had in mind are deemed harmless.

The petition has been considered but is denied with respect to making any change in the decision dated April 16, 1984.


Donald J. Quigg
Deputy Commissioner of Patents and Trademarks